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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Masahiro IMOTO et al.

Serial No.: 10/009,607

Group Art Unit: 1624

Filed: November 21, 2000

Examiner: Deepak R. RAO

Title: SUBSTITUTED 1-AZA-2-IMINO-HETEROCYCLES AND  
THEIR USE AS NICOTINIC ACETYLCHOLIN RECEPTORS  
ACTIVATORS

REPLY TO OFFICE ACTION

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MAY 14 2003

Commissioner for Patents  
Washington, D.C. 20231

TECH CENTER 1600/2900

Sir:

Responsive to the Office Action dated April 9, 2003 in the above-captioned application, applicants hereby provisionally elect Group III, that is, the compounds of formula (I) wherein the ring is imidazole or imidazoline (i.e., -Y-X-represents -CH<sub>2</sub>-CH<sub>2</sub>-NH- or -C(R<sup>7</sup>)=C(R<sup>8</sup>)-N=). This provisional election is made **with** traverse.

The attempted restriction is traversed because an attempt to restrict within a single claim is improper. The reason it is improper is because such an attempted restriction is in derogation of the applicant's statutory right to define what he regards as his invention and to have each claim examined in its full scope.

An applicant's statutory right to present claims which define a claimed invention in a scope which the applicant regards as his invention is established by the second paragraph of 35 U.S.C. §112. This right was clearly enunciated by the Court of Customs and Patent Appeals in the case of *In re Weber*, 198 USPQ 328 (CCPA 1978). There, Judge Baldwin, writing for the court stated as follows:

An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of Section 112. We have decided in the past that Section 112, second paragraph, which says in part “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention,” allows the inventor to claim the invention as he contemplates it. *In re Wolfrum*, 486 F.2d 588, 179 USPQ 620 (CCPA 1973).

As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. *In re Weber* 198 USPQ 328, 331 (CCPA 1978) (emphasis in original).

Thus, the court clearly ruled that an applicant has a right to have each claim examined on its merits in its full scope.

In his concurring opinion, Judge Rich added an elaboration of additional points he wanted to make clear as follows:

The practice here challenged is tantamount to a refusal by the PTO to *examine* a single Markush claim in a single application because, in its opinion, it is *broad* enough to “embrace” or “cover” a plurality of inventions which, if presented separately, would be separately patentable, *assuming* any one of them to be prior art....

The fault in the PTO position is that it overlooks the obvious fact that almost any reasonably broad claim “embraces” or “covers” a multiplicity of inventions, in the sense of “dominating” them, which inventions might be separately patentable if and when presented in separate applications. Logically, this is not a sufficient excuse for refusing to examine a claim on its merits for compliance with 35 USC 101, 102, 103, and 112....

The only justification or statutory authority put forward for refusing to examine is 35 USC 121. There is nothing therein, however, to excuse a refusal to examine an elected invention or an applicant's generic (broad) claim reading thereon, notwithstanding the generic claim reads on nonelected inventions and possibly many others, all potentially separately patentable....

As for the true meaning of the words "two or more independent and distinct inventions are claimed" in §121, being based -- as they were -- on the "division" practice existing in the then Patent Office in 1952, there can be no doubt they refer to separate inventions separately claimed and to a requirement to put separate claims in separate applications or at least to restrict one application to one claimed invention. There is no indication that enactment of §121 contemplated refusing examination to generic claims because of their scope or that applicants were to be denied the right to present single claims of any breadth they chose and have them examined. *In re Weber* 198 USPQ 328, 333-4 (CCPA 1978) (emphasis in original).

Judge Rich, who himself was one of the authors of the Patent Statute, thus makes it clear that restriction practice was intended to apply between separate claims, but was never intended to deny an applicant the right to have a single claim examined in its full scope.

Applicants therefore respectfully submit that the attempted restriction within a single claim is not justified under Section 121 of the Patent Statute, and is in derogation of applicants' statutory right under Section 112, second paragraph, to claim what they regard as their invention. Reconsideration and withdrawal of the attempted restriction are therefore respectfully requested.

Notwithstanding the error in the restriction requirement as a whole, it is pointed out that the restriction as between Groups II and III, Groups V and VII, and Groups I and VI is improper. In Group III, the -Y-X- groups are homologs of the corresponding groups of Group II; in Group VII, the -Y-X- groups are homologs of the corresponding groups of Group V; in Group I, when X is oxygen the -Y-X- groups are homologs of the corresponding groups of Group VI.

The Examiner also required an election of species within the elected Group. In response to that requirement, Applicants provisionally elect compound No. 7, that is, 2-amino-1-[2-(6-chloro-3-pyridyl)ethyl]imidazole. It is

understood that when the Examiner eventually allows a generic claims, the other species will also be examined.

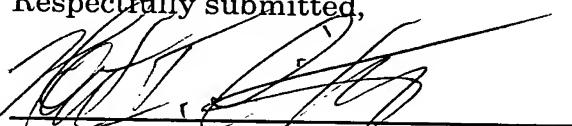
Claims 1-34 are all generic and read on the provisionally elected species.

The foregoing provisional elections were made without prejudice to Applicants' right to file one or more divisional applications covering the provisionally non-elected subject matter.

Since all formal matters have been attended to, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

May 9, 2003

  
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